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Andre M. Gibbs
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID GAXIOLA, JOSEPH ALEXANDER DARA-ABRAMS,
RAVI GAUBA, JUN OUYANG, and KLAUS HOFRICHTER

Appeal 2008-3095
Application 10/033,407¹
Technology Center 2100

Decided:² April 17, 2009

Before LEE E. BARRETT, JEAN R. HOMERE, and
THU A. DANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on December 26, 2001. The real parties in interest are Sony Electronics, Inc., and Sony Corp.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 2, 4 through 11, and 13 through 32. Claims 3 and 12 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Appellants' Invention

Appellants invented a method and system for configuring a shared access device on a home network according to the preferences of a user. (Spec. 2, ¶ [0004].) In particular, Figure 1 depicts a home network (100) having a plurality of user electronic devices (e.g. a cell phone (110), a digital camera (120), a digital audio player (130)) coupled to a set top box (145) that includes a custom settings manager (150), and is paired with a shared network access device (e.g. a TV, a DVD, a stereo system, a cable box) (160). (*Id.* at 3, ¶ [0011].) Upon detecting that a user electronic device is coupled to the home network, the custom settings manager (150) identifies the user associated with the detected device, as well as the preferences associated therewith to subsequently load on the shared network access device (160) the preferred services for the identified user. (*Id.* at 4-5, ¶¶ [0013-0016].)

Illustrative Claim

Independent claim 1 further illustrates the invention as follows:

1. A computerized method comprising:

detecting, by a custom settings manager, a coupling of a consumer device to a network;

remotely identifying a presumed user corresponding to an implied owner of the consumer device;

provisioning a user service available in the network according to user preferences associated with the identified presumed user; and

configuring a shared network access device according to the user preferences, wherein the shared network access device is accessible by the consumer device and by another device coupled to the network.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Norris	US 5,557,748	Sep. 17, 1996
Ricart	US 2002/0165906 A1	Nov. 07, 2002 (filed Jun. 25, 2001)
Bunney	US 6,487,584 B1	Nov. 26, 2002 (filed Mar. 17, 1999)
Dharmadhikari	US 2003/0065816 A1	Apr. 03, 2003 (filed Sep. 28, 2001)
Reed	US 6,754,504 B1	Jun. 22, 2004 (filed Jun. 10, 2000)
Narayanaswami	US 6,980,175 B1	Dec. 27, 2005 (filed Jun. 30, 2000)

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 1, 2, 4, 5, 10, 11, 13, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Norris in view of Ricart and further in view of Narayanaswami.

Claims 6 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Norris in view of Ricart further in view of Narayanaswami as applied to claims 1 and 10 above, and further in view of Dharmadhikari.

Claims 7- 9 and 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Norris in view of Ricart further in view of Narayanaswami as applied to claims 1 and 10 above, and further in view of Reed.

Claims 19, 20, 23-26, 29-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dharmadhikari in view of Ricart further in view of Narayanaswami.

Claims 21 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dharmadhikari in view of Ricart further in view of Narayanaswami as applied to claims 19 and 25 above, and further in view of Norris.

Claims 22 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dharmadhikari in view of Ricart further in view of

Narayanaswami as applied to claims 19 and 25 above, and further in view of Bunney.

Appellants' Contentions

Appellants argue that the combination of Norris, Ricart, and Narayanaswami does not teach configuring a shared network access device according to a user's preferences, wherein the shared network access device is accessible by the user device and another device coupled to the network, as recited in independent claim 1. (App. Br. 3-4³; Reply Br. 2.) In particular, Appellants argue that while Narayanaswami discloses configuring a consumer device (e.g. a personal computer, a personal digital assistant or a cell phone), the disclosed device is not a shared network access device that can be accessed by a consumer device and another device. (*Id.*)

Examiner's Findings/Conclusions

The Examiner finds that Narayanaswami's personal smart pointer device teaches the consumer electronic device, and that the disclosed computer (e.g. PDA or wireless phone) connected to the personal smart pointer device teaches the shared network access device. (Ans. 4-5, 16.) Further, the Examiner finds that Narayanaswami discloses a network wherein the personal smart pointer transfers a user's preferences to the computer coupled thereto to thereby personalize or configure the computer

³ See Appeal Brief filed Jan. 28, 2008.

according to user preferences. (*Id.*) The Examiner also finds that the networked computer can be accessed by the smart pointer device as well as other networked devices. (*Id.*) Additionally, the Examiner finds that it was widely known that a networked device can be accessed by more than one device on the same network.⁴ (*Id.* 16-17.) The Examiner therefore concludes that the combination of Norris, Ricart, and Narayanaswami renders independent claim 1 unpatentable. (*Id.*)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Norris, Ricart and Narayanaswami renders independent claim 1 unpatentable? In particular, the issue turns on whether Narayanaswami teaches configuring a shared network access device according to a user's preferences, wherein the shared network access device is accessible by the user device and another device coupled to the network.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

⁴ Appellants object to this finding as being equivalent to the Examiner taking an official notice of the stated fact for the first time in the Answer. Appellants argue that this amounts to the Examiner making a new ground of rejection in the Answer without explicitly stating so. Appellants, thus, request the Examiner to provide support for this position, and further allege that a server cannot access the personal computer. (Reply Br. 2-3.)

Narayanaswami

1. As depicted in Figure 3, Narayanaswami discloses a personal smart pointer device (10) that readily connects with any computer (21, 22) to facilitate network computer like applications. In particular, the personal smart pointer device transfers a user's personal preferences stored thereon to devices (computer, PDA, cell phone) connected thereto to thereby customize such devices in accordance with the transferred preferences. (Abstract; col. 7, ll. 5-16.)

IV. PRINCIPLES OF LAW

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 404 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art" and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 401 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)) (citation omitted). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 414, 401.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 414). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d at 987-988; *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (citation omitted).

V. ANALYSIS

Claims 1, 4, 5, 10, 11, 13, and 14

Independent claim 1 recites, in relevant part, configuring a shared network access device according to a user's preferences, wherein the shared network access device is accessible by the user device and another device coupled to the network.

As set forth in the Findings of Facts section, Narayanaswami discloses a network computer-like environment, wherein a personal smart pointing device transfers a user's preferences to a computer connected thereto to personalize or customize the computer according to the transferred preferences. (FF 1.) We find that Narayanaswami's personalization of the computer teaches configuring the computer using or according to the transferred user preferences. Further, we agree with the Examiner that the computer device is a shared network access device. One of ordinary skill in

the art would readily recognize that the computer, by dint of being on the network, would allow various owners of personal smart pointing devices to transfer their personal preferences to the computer to thereby configure the computer according to their own personal preferences. Therefore, we find that Narayanaswmi's disclosure fairly and reasonably teaches that the networked computer is capable of being accessed by more than one personal smart pointing device coupled to the network or by a user's device coupled thereto other than the identified personal smart pointing device.

Additionally, we note that independent claim 1 recites that the shared network access device is *accessible* by the consumer device and by another device coupled to the network. We find that the cited recitation merely requires the shared network access device to be *capable of* being accessed by the consumer device and another device coupled to the network. Such recitation does not require, however, that the shared network access device actually be accessed by the two devices on the network. We thus find that the cited capability of accessing the shared network access device to be simply a statement of intended use, which is not entitled to any patentable weight. A statement of intended use in an apparatus claim cannot be used to distinguish over the prior art apparatus. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). A claimed apparatus must be described by its structure, not its intended use. The mere recitation of an intended use in a claim will not be given any patentable weight. *Application of Dense*, 156 F.2d 76 (CCPA 1946). *See also Ex Parte James A. Satchell*, Appeal 2008-

0071, 2008 WL 4828136, (BPAI 2008). Because the claimed capability of pairing the two devices is statement of intended use, Appellants cannot properly rely upon such statement to patentably distinguish the claim over the prior art of record. It follows that Appellants have not shown that the Examiner erred in concluding that the proffered combination renders independent claim 1 unpatentable.

Appellants did not provide separate arguments with respect to the rejection of claims 1, 4, 5, 10, 11, 13, and 14. Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, claims 4, 5, 10, 11, 13, and 14 fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 2, 6 through 9, 12, and 15 through 32

Appellants argue that the various combinations of references proffered by the Examiner to reject the cited claims are deficient since none of the references relied upon cures the alleged deficiencies of Narayanaswami, as set forth above. (App. Br. 4-7.) As discussed above, we do not find any such deficiencies in Narayanaswami. It follows that Appellants have not shown error in the Examiner's rejection of those claims.

VI. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1, 2, 4 through 11, and 13 through 32 as set forth above.

VII. DECISION

We affirm the Examiner's decision to reject claims 1, 2, 4 through 11, and 13 through 32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

Andre M. Gibbs
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles CA 90025-1026